

**REMARKS**

Reconsideration of the present application, in view of the following remarks, is respectfully requested. No claims have been amended, canceled, or added. Therefore, claims 1-3, 5-8, 13-20, 26, 27, 30, and 31 remain pending in the present application.

Claims 1-3, 5, 6, 13-19, 26, 27, 30, and 31 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,456,749 to Kasabach ("Kasabach"). Claims 1 and 18, as pending, recite the features of "a specially formatted surface including a predefined address pattern..." and "an electronic pen for detecting a portion of the predefined address pattern adjacent to the electronic pen, wherein a position of the electronic pen on the specially formatted surface can be determined using the detected portion of the predefined address pattern... ."

In the Office Action, it is asserted that the specially formatted surface of claims 1 and 18 is analogous to reference number 14 of Kasabach. Applicants respectfully disagree. Reference number 14 of Kasabach refers to a writing surface position indicator. "The writing surface position indicator 14 is affixed to or engaged with the writing surface and transmits a signal to one or more sensors in the housing." See col. 3. lines 1-2 and 23-27 of Kasabach. As shown in Figures 1, 3-7, the writing surface position indicator is a clamp or U-shaped device that fits over an edge of a paper. Kasabach mentions that the writing surface position indicator may be a magnetic substance. However, the magnetic substance or other embodiments of the writing surface position indicator are not analogous to a specially formatted surface as recited in claims 1 and 18. Moreover, the specially formatted surface of claims 1 and 18 does not transmit a signal to a sensor in the electronic pen.

Furthermore, it is asserted that the electronic pen of claims 1 and 18 is analogous to reference number 12 of Kasabach. Applicants respectfully disagree. Reference number 12 refers to a writing instrument such as a pen, pencil, chalk, etc. that enables the user to place marks on a surface. See col. 3, lines 2-7 of Kasabach. The writing instrument may include a sensor for sensing a magnetic field emitted by a magnetic substance, however, sensing a magnetic field is not equivalent to detecting a portion of the predefined address pattern adjacent to the electronic pen. The magnetic sensor does not read any indicators from the surface of the paper. Instead, in Kasabach, the magnetic sensor senses the magnetic field.

In addition, Kasabach does not expand on the magnetic surface or magnetic sensor. As stated in MPEP §2121.01 “in determining the quantum of prior art disclosure which is necessary to declare an applicant’s invention ‘not novel’ or ‘anticipated’ within section 102, the stated test is whether a reference contains an ‘enabling disclosure’... . A reference contains an ‘enabling disclosure’ if the public was in possession of the claimed invention before the date of invention. Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his [or her] own knowledge to make the claimed invention.”

Applicants assert that Kasabach does not enable one skilled in the art to make or use the magnetic substance or the magnetic sensor. No information is given as to how the magnetic substance is applied to a surface, in what orientation the magnetic substance is applied, or how the magnetic sensor determines the location of the writing instrument based on the sensed magnetic field. Applicants submit that claims 1 and 18 distinguish over Kasabach and request that the §102 rejection of claims 1 and 18 be withdrawn.

Claims 2, 3, 5, 6, 13-17, 19, 26, 27, 30, and 31 are either directly or indirectly dependent from claim 1 or 18 and should distinguish over Kasabach for at least the same reasons as stated above. Applicants respectfully request that the §102 rejection of claims 2, 3, 5, 6, 13-17, 19, 26, 27, 30, and 31 be withdrawn.

Claims 7, 8, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kasabach in view of U.S. Patent No. 5,739,810 to Merkel (“Merkel”). Claims 7, 8, and 20 are either directly or indirectly dependent from claim 1 or 18 and should distinguish over Kasabach for at least the same reasons as stated above. Merkel does not remedy the deficiencies of Kasabach in that Merkel also does not teach a specially formatted surface including a predefined address pattern or an electronic pen for detecting a portion of the predefined address pattern adjacent to the electronic pen. In addition, Merkel does not provide enablement for the magnetic substance and magnetic sensor of Kasabach. Applicants submit that claims 7, 8, and 20 distinguish over Kasabach and Merkel, taken alone or in combination, and request that the §103 rejection of claims 7, 8, and 20 be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

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